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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,690	04/17/2001	Bernard Gilder	00216-396003 / Case 4225	7984

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BOSTON, MA 02110

EXAMINER

PETERSON, KENNETH E

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 04/01/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/836,690

Applicant(s)

GILDER ET AL. *MT*

Examiner

Kenneth E Peterson

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 4-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3724

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1,3 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,6 and 8 of U.S. Patent No. 6,216,349. Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the subject matter of current claims 1,3 and 12 can be found in claims 1,6 and 8 of U.S. Patent No. 6,216,349.

3. Claims 1,3 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,2 and 3 of U.S. Patent No. 6,212,777. Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the subject matter of current claims 1,3 and 12 can be found in claims 1,2 and 3 of U.S. Patent No. 6,212,777.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1,3,12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Welsh who shows a razor having a guard (e.g.19), a cap (e.g.20) and three parallel blades (line 54 of column 2).

Welsh does not set forth the specific blade exposures from Applicant's claim 1. However, on lines 31-33 of column 4, Welsh states that "*the second or follower blade can be given a greater exposure than would be desirable for the first or leading blade*". Welsh goes on to say that "*Either the leading blade or both blades may be given a negative exposure*".

Given Welsh's teaching that the leading blade could have a negative exposure, and Welsh's teaching that following blades should have a higher, non-negative exposure, and Welsh's teaching that following blades can have a positive exposure, it would have been obvious to one of ordinary skill in the art to have set the blade so that the first blade had a negative exposure and the third blade have a positive exposure.

More generally, Welsh teaches having a exposure differential of +0.003" between leading blades and following blades. Welsh gives examples of exposures for the leading blades of -0.003" and +0.003", but one of ordinary skill would recognize that one could pick any exposure therebetween as a starting point. For example, for the exposure of the leading edge, one could pick -0.001". Following Welsh's teachings, the second blade would have an exposure 0.003" higher, which would be 0.002", and the third blade would have an exposure 0.003" higher, which would be 0.005".

In regards to claims 3 and 12, Welsh's drawings show spans between the guard and the first and second blades that are roughly proportional to Applicant's claimed spans. If it is interpreted that Welsh's spans are not 1mm, 1.5mm, 1.5mm respectively, then it is deemed that it would have been obvious to one of ordinary skill in the art to have arrived at these numbers by routine experimentation because the specific spans do not offer unexpected results that differ in kind and not merely in degree from the spans of Welsh. In re Aller, 105 USPQ 233 (CCPA 1955).

6. Applicant's arguments have been fully considered but they are not persuasive.

On lines 27-53 of column 4, Welsh states that the blades act in succession and that the following blades should have greater exposure. Welsh also teaches having three blades (line 54, column 2). In order to comply with Welsh's teaching, one of ordinary skill would place each of the following blades at a greater exposure, thus resulting in the claimed invention.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

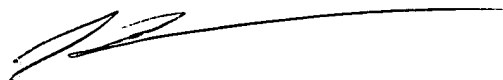
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Peterson whose telephone number is 703-308-2186. The examiner can normally be reached on Monday thru Thursday between 7am and 4pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9302. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.

kp
March 25, 2003



**KENNETH E. PETERSON
PRIMARY EXAMINER**